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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,651	08/05/2003	Ching-Jung Tu	3722-0156P	5462

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BIRCH STEWART KOLASCH & BIRCH  
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FALLS CHURCH, VA 22040-0747

EXAMINER
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SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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08/27/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/633,651	TU, CHING-JUNG	
	<b>Examiner</b>	<b>Art Unit</b>	
	Houshang Safaipoor	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/03.

4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

The recitation regarding "...scanning a first document without a laser/anti-counterfeit mark and a second document with the laser/anti-counterfeit mark..." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al. (US 6,919,974).

Regarding claim 1, Ichikawa discloses an image reading device comprising:

a scan module (figs. 13 and 14) comprising:

Although Ichikawa's invention is directed towards using a single light source with capability of emitting visible and infrared light rays selectively (col. 1, line 59 to col. 2 line 1), he, in his background of invention discloses that there is "...a technique proposed such that a

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visible light source and an infrared light source are individually provided in a single device” (col. 1, lines 22-24). Therefore it would have been obvious to a person of ordinary skill in the art to modify Ichikawa’s device to incorporate a first light source enabled to emit visible light rays to illuminate the first document; a second light source enabled to emit infrared light rays to illuminate the second document (please refer to figs. 13 and 14, also col. 11 lines 4-12);

an image sensor (67, figs. 13 and 14) ; and

a lens module (66) for focusing reflected light rays from the first or second document onto the image sensor (67); and

a scan mode control unit for controlling the scan module to selectively enable the first light source and the second light source to perform a first mode scan or a second mode scan (please refer to the discussion above and col. 1, line 59 to col. 2 line 1 and col. 11 lines 4-12).

Regarding claim 2, Ichikawa discloses the scanner according to claim 1, further comprising: a scan mode selecting unit controlled by a user to select one of the first mode scan and the second mode scan and transfer a selected result to the scan mode control unit, which controls the scan module to perform the first mode scan or the second mode scan (please refer to the discussion above and col. 1, line 59 to col. 2 line 1).

Regarding claims 3 and 4, Ichikawa discloses providing “first reading mode selection signal” (col. 12 line 20) and “second reading mode selection signal” (col. 13 line 10). However, he is silent on how the selection is made. Selecting modes of operation by utilizing a button or a switch is well known and routinely implemented in the art (Official Notice). Therefore it would have been obvious to a person of ordinary skill in the art to add buttons or switches to Ichikawa’s device for selection of the mode of operation.

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Regarding claim 5, please refer to the discussion under claims 3 and 4. Also, location of the scan button is a matter of a design choice. Therefore it would have been obvious to a person of ordinary skill in the art to mount the scan button at a bottom on the device to be enabled by pressing the top of the scanner.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Trantoul (US 6,494,490).

Regarding claims 6 and 7, Trantoul discloses a method for a multi-function scanner for scanning a document with a laser/anti-counterfeit mark, the method comprising the steps of: pre-scanning the document to obtain a preview image; recording a zone of the laser/anti-counterfeit mark selected by a user on the preview image as a marked zone (col. 14, lines 1-35); using a visible light source to scan the document so as to obtain a first image corresponding to the document excluding the marked zone (col. 14, lines 36-47); using an infrared light source to scan the document so as to obtain a second image corresponding to the marked zone; and combining the first image with the second image (col. 14 line 61 to col. 15 line 14). Please also refer to col. 15 lines 15-35).

***Allowable Subject Matter***

5. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Fri. from 6:00am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Houshang Safaipoor  
Patent Examiner  
August 14, 2007

